



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of:	)	<u>Group Art Unit:</u> 2611
	)	
Ta-Ching PONG	)	<u>Examiner:</u> N. Vu
	)	
Serial Number: 09/881,815	)	<u>Attorney Docket:</u> PONG3002beu
	)	
Filed: June 18, 2001	)	<u>Confirmation No.:</u> 9271

For: System And Method For Insertion And Modification Of Advertisements

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Honorable Commissioner For Patents  
P.O. Box 1450  
Alexandria, VA. 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application.  
No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reasons stated on the attached sheets (no more than 5 pages are provided).

I am the attorney or agent of record.

Respectfully submitted,  
BACON & THOMAS, PLLC

Date: November 7, 2006

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Serial Number 09/881,815

Attachment to Pre-Appeal Brief  
Request for Review  
Examiner B. Hayes  
Group Art Unit 3641

**REASONS FOR REQUESTING REVIEW OF THE FINAL REJECTION**  
**(Attachment to Pre-Appeal Brief Request for Review)**

Review of the final rejection of claims 1-8 and 11-13 is requested for the following reasons:

1. Rejection of Claims 1, 2, 7, 14, and 15 in view of Jeannin and Kitsukawa

This rejection is respectfully traversed on the grounds that the Jeannin publication and the Kitsukawa patent fail to disclose or suggest, whether considered individually or in any reasonable combination, the claimed updating of advertisements inserted into *interactive* programs, based on user responses to program *content*.

Claim 1 specifically recites:

1. (Currently Amended) A method of delivering advertising and/or commercials to a user, viewer, or consumer via composite images displayed to the user, viewer, or consumer through a media display device, comprising the steps of:  
displaying a program; and  
inserting, while said program is being displayed, an advertisement into a selected portion of the displayed program, said advertisement being displayed in a manner appropriate to a content of the displayed program so that the advertisement appears to be a part of said content,  
wherein said program is an interactive program, said program having several possible paths, said paths being determined by responses by the user, viewer, or consumer to said content, and wherein said advertisement is updated based on said responses to said content, said responses to said content being submitted by the user, viewer, or consumer, via an interface device.

Contrary to the paragraph bridging pages 2 and 3 of the Official Action, which allege that an interactive program and insertion of ads based on viewer responses is not claimed, claim 1 in fact recites inserting an advertisement into a program, and further recites that the insertion occurs “while said program is being displayed.” Furthermore, claim 1 recites that the program is an “interactive program,” that the user selects paths based on “responses to program content,” and that the advertisement is “updated” based on “response to content.” For example, during the program, the user might be presented with a program path in which the user selects a car to drive during a race. As the program proceeds, advertisements in the background of the race track are

updated to show particular types of cars that may be of interest to the user based on the selected car. As explained on page 14 of Applicant's specification (item iv in lines 19-21), the user can select the ad in order to view details or simply proceed with the program. The option of selecting the ad would be similar to selection of the icon taught by Jeannin, but Jeannin's icons are not inserted into the program in a manner appropriate to content of the program and, even if Jeannin's icons were inserted in a manner appropriate to program content, the icon thus inserted could not reasonably be said to be "updated based on said responses to said content," *i.e.*, on responses that determine multiple paths of an interactive program, as claimed.

Instead of insertion into a multiple path interactive program, the Jeannin publication discloses insertion of advertisements into ordinary non-interactive video programs, *i.e.*, programs in which viewer choices do not affect the content of the program, while the Kitsukawa publication discloses **superposition of icons or text** onto a program, the icons or text enabling selection of an advertisement, also **without affecting the content** of the program. Thus, neither the Jeannin publication nor the Kitsukawa publication discloses or suggests updating of advertisements inserted into interactive programs, much less insertion of advertisements into interactive programs based on user responses to program content. **In the claimed invention, the user interacts with a program, and ads are updated based thereon. In Jeannin, ads are pre-inserted into a program with no interaction. In Kitsukawa, ads (coupons) may be selected by a user, but the selection of ads has nothing to do with program content.**

Basically, the advertisement insertion of the prior art involves user responses to "ad marks" in the program. There is no suggestion in any of the references having the user modify the program itself, *i.e.*, of an interactive program, and of using viewer responses to update inserted ads. For example, as depicted in Fig. 3 of the Jeannin publication and described in paragraph [0036], advertisements are inserted into the video stream at the time of authoring (step 100) and *before* transmission or broadcast. As a result, reactions of the user to the content of the broadcast do not affect the advertisements. There is no user interaction with the program itself.

In the paragraph bridging pages 6 and 7 of the final Office Action, the Examiner cites Kitsukawa's teachings of scene 902 and **coupon** information alerts as being suggestive of advertisement selection based on program content. However, **coupon alerts** 920-924 are NOT selected based on interaction with program content (any more than the ad icons described in a previous response). The program of Kitsukawa is NOT interactive. The coupon alerts are predetermined, and furthermore are merely alerts that a coupon is available for recall by the viewer. Selection of a coupon has no affect on program path, which is not variable.

These distinctions may again be summarized as follows:

- |            |   |
|------------|---|
| Claimed:   | <ul style="list-style-type: none"> <li>• <b>Interactive Program with Multiple Paths</b></li> <li>• Advertisement Updated Based, at least in part, on <b>Viewer Path Selection</b></li> <li>• Selected Advertisement Appears as <b>Part of Program Content</b></li> </ul>  |
| Jeannin:   | <ul style="list-style-type: none"> <li>• Regular "Broadcast" Program—<u><b>No Path Choosing Option</b></u></li> <li>• Advertisements embedded in program before broadcast—<u><b>Not Affected by Program Content</b></u></li> </ul>  |
| Kitsukawa: | <ul style="list-style-type: none"> <li>• Regular "Broadcast" Program—<u><b>No Path Choosing Option</b></u></li> <li>• Advertisement Selected Based on Viewer Selection of Icon or Text (Coupon Alert)—Has <u><b>NO effect on Program Content</b></u></li> <li>• Selected Advertisement Superimposed on Program, <u><b>Does NOT Appear as Part of Program Content</b></u></li> </ul> |

The claimed invention is essentially the converse of what is taught by Jeannin, since the insertion of ads in Jeannin is the result of a library of previous ad selections rather than the result of responses to the content of the programs into which the ads are inserted, as illustrated by the following:

<u>Jeannin:</u> insert ads into non-interactive program	→	viewer selects ads	→	previous ad selections used to determine future ad insertions
<u>Claimed:</u> play interactive program	→	viewer responds to program content	→	viewer <u>responses to program content</u> determines future ad insertions

Kitsukawa:      insert markers into      →      viewer selects marker      →      ad is displayed  
non-interactive  
program

Since the Jeannin publication and Kitsukawa patent do not concern such interactive programs, and in particular do not disclose or suggest insertion of advertisements into a program based on viewer reactions to program content (as opposed to viewer selection of particular advertisements), withdrawal of the rejection of claims 1, 2, 7, 14, and 15 under 35 USC §103(a) is respectfully requested.

The Wilf patent, like the Kitsukawa patent and Jeannin publication, does not disclose or suggest insertion of advertisements into an interactive program based on selection of multiple program paths, as recited in claim 1. Instead, the Wilf patent is directed to systems for locating and replacing billboards that appear in broadcast television programs, and does not anywhere mention processing, transmission, or reply to viewer responses to the replacement “billboards.

The Tanabe publication, like the Kitsukawa patent and Jeannin publication, does not disclose or suggest insertion of advertisements into an interactive program based on responses submitted by the user, via an interface device, to the main program. While the Tanabe publication is directed to interactive advertisements, it does not seek to insert advertisements into a video program or on-line game, but rather simply adds a “browser unit” to a television broadcast receiver so as to HTML graphic displays (webpages) which are displayed. These webpages are

not integrated into the program in the claimed manner and, while viewer data is solicited in the form of “limiting information” (see, col. 6, paragraph [0097]) and responses to the advertisements in the form of purchase orders may also be solicited, there is no attempt to *modify* or select inserted advertisements based on the viewer responses to the advertisements.

5. Rejection of Claim 11 in view of Jeannin, Kitsukawa, and Stautner

The Stautner patent, like the Jeannin publication and Kitsukawa patent, does not disclose or suggest insertion of advertisements into an interactive program based on responses submitted by the user, via an interface device, to either the main program or to a previously inserted advertisement. Instead, the Stautner patent discloses embedding of web-based content into broadcast program guides. As in the Tanabe system discussed above, response to an advertisement in the Stautner system does not modify the manner in which advertisements are inserted.

6. Rejection of Claim 12 in view of Jeannin, Kitsukawa and Gautier

The Gautier patent relates solely to user identification, and therefore does not suggest modification of the system disclosed in the Jeannin publication (whether or not considered in view of the Kitsukawa patent) to provide for insertion of advertisements into an interactive program based on responses submitted by the user, via an interface device, to either the main program or to a previously inserted advertisement.

7. Rejection of Claim 13 in view of Jeannin, Kitsukawa, Stautner, and Tomsen

The Tomsen publication is directed to a system that permits a viewer of a commercial on interactive television to save the commercial for later viewing and interaction, and therefore could not possibly have suggested modification of the system of Jeannin, whether or not considered in view of the Kitsukawa and Stautner patents, to provide for insertion of advertisements into an interactive program based on responses submitted by the user, via an interface device, to either the main program or to a previously inserted advertisement.